

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
Stanley et al.) Patent Pending
Serial No.: 10/797,490)
Filed: **March 10, 2004**) Examiner: Aaron Austin
For: **Artificial Christmas Tree**) Group Art Unit: 1775
Attorney's Docket No: **4486-096**) Confirmation No.: 5656

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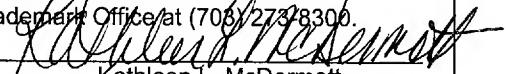
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Kathleen L. McDermott

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Dear Sir or Madam:

This appeal brief is being filed in response to the Notice of Non-Compliant Appeal Brief dated January 14, 2008. Although no fees should be required, if any are, please charge the balance to Coats & Bennett Deposit Account No. 18-1167.

APPEAL BRIEF

(I.) REAL PARTY IN INTEREST

The real party in interest is Virgil E. Stanley, III

(II.) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(III.) STATUS OF CLAIMS

Claims 1, 5-9 and 18-26 are pending and are appealed herein. Claims 10, 12, 13, 15-17 and 27-29 have been withdrawn from consideration. Claims 2, 3, 4, 11 and 14 have been canceled.

(IV.) STATUS OF AMENDMENTS

All amendments have been entered.

(V.) SUMMARY OF CLAIMED SUBJECT MATTER

The application includes 2 independent claims: 1 and 18.

Claim 1 is directed to an artificial Christmas tree 200 comprising a trunk 212 having an air passageway formed therein and a series of Christmas tree branches 216 adapted to extend from the trunk. See page 19, lines 1-3, 18-22 and as shown in Figure 11. The claim further requires a fragrance source 222 associated with the Christmas tree for emitting a fragrance. See page 20, lines 11-13 and as shown in Figure 11. In addition, the claim requires a fan to move air across the fragrance source 222 to form an air-fragrance mixture and to move the air-fragrance mixture through at least a portion of the trunk. See page 21, lines 8-9 and page 22, line 21 through page 23 line 5 and as shown in Figure 12.

Claim 18 is directed to an artificial Christmas tree 200 comprising a hollow trunk 212 and a plurality of branches 216 extending from the hollow trunk 212. See page 19, lines 1-3, 18-22 and as shown in Figure 11. The artificial Christmas tree 200 also includes an artificial fragrance source 222 associated with the artificial Christmas tree 200. See page 20, lines 11-13 and as shown in Figure 11. The artificial fragrance source 222 is adapted to emit an artificial fragrance. See page 20, lines 11-13 and as shown in Figure 11. The claim further includes a fan configured to direct air past the fragrance source 222 to form an air-fragrance mixture and to

move the air-fragrance mixture through at least a portion of the hollow trunk 212. See page 21, lines 8-9 and page 22, line 21 through page 23 line 5 and as shown in Figure 12.

(VI.) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 7-9 and 18, 19, 22, 23, 25 and 26 are obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 6,696,116 (hereinafter “Bigman”) in view of U.S. Patent No. 5,455,750 (hereinafter “Davis et al.”).

Whether claims 5, 6 and 20 are obvious under 35 U.S.C. §103(a) over Bigman, in view of Davis et al., and further in view of U.S. Patent No. 5,517,390 (hereinafter “Zins”).

Whether claims 21 and 24 are obvious under 35 U.S.C. §103(a) over Bigman, in view of Davis et al., and further in view of Japanese Patent JP405306833A (hereinafter “Hashino”).

(VII.) ARGUMENT

A. The Law of Claim Construction and Obviousness

In construing a claim term the Examiner must give the claim term its plain and ordinary meaning unless the inventor specifically defines a term in the specification. It is true that in giving a claim term its plain and ordinary meaning, the Examiner can give the claim term its broadest reasonable interpretation. *In re Baker Hughes, Inc.*, 215 F.3d 1297 (Fed. Cir. 2000). However, the broadest reasonable interpretation must be reasonable and must be consistent with the specification and in harmony with how a person of ordinary skill in the art would construe the claim term in light of the specification. *In re Hyatt*, 211 F.3d 1367 (Fed. Cir. 2000). Moreover, the context of the surrounding words of the claim is considered in determining the ordinary and customary meaning of the claim terms. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

After the claim terms have been properly construed, the Examiner bears the initial burden of making out a *prima facie* case of obviousness under § 103. It is incumbent upon the

Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.* and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966). Such reason must stem from some teaching, suggestion or motivation in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988).

The mere fact that prior art can be modified to form a claimed invention does not make that modification obvious absent a showing that the prior art or knowledge generally available to one having ordinary skill in the art suggests the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Moreover, if the proposed modification of the prior art reference destroys the intended function of the prior art, then there is no reason to make the modification and the obviousness rejection fails. See *In re Fitch*, 972 F.2d 1260, 1265 FN. 12, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

B. Claims 1, 7-9, 18, 19, 22, 23, 25 and 26 Are Not Obvious over Bigman in view of Davis et al.

Claim 1 is representative and is as follows:

An artificial Christmas tree comprising:

- a. a trunk having an air passageway formed therein;
- b. a series of Christmas tree branches adapted to extend from the trunk;
- c. a fragrance source associated with the Christmas tree for emitting a fragrance; and
- d. a fan to move air across the fragrance source to form an air-fragrance mixture and to move the air-fragrance mixture through at least a portion of the trunk.

1. The Examiner's misconstrues the term "trunk."

Both independent claims 1 and 18 include limitations to an artificial tree comprising a "trunk." The Examiner unreasonably interpreted "trunk" so broadly as to include Bigman's tube 16. Final Office Action, p. 2, ¶ 3. Specifically, Examiner maintains that the term "trunk" refers merely "the axis of a tree." Final Office Action, p. 5, ¶ 1. Further, the Examiner cites Merriam – Webster dictionary to state the term "trunk" means "the main stem of a tree apart from the roots" or "the central part of anything; specifically, the shaft of a column or pilaster." However, even these definitions of "trunk" are inconsistent with the Bigman's tube. Indeed, Bigman's tube is not the main stem or the central part of the tree. Rather, Bigman discloses a central primary support 14a in addition to the tube 16. In fact Bigman states, the "[t]ube 16 is supported on the support 14a for the tree." Bigman, col. 2, lines 46-47; see Figure 4. Because Bigman's tube itself provides no support to the tree and cannot properly be construed as a "trunk." The Examiner's proffered construction of "trunk" is unreasonably broad and inconsistent with the specification and the plain and ordinary meaning of the term.

In addition, the Examiner does not appreciate the law of claim construction as it applies to ex parte prosecution. The Examiner does not acknowledge the basic rule that a term must be given its plain and ordinary meaning unless inconsistent with the specification. Indeed, the Examiner states that he is entitled to give the term "trunk" its "broadest interpretation." Final Office Action, p. 5, ¶ 1. The Examiner is not entitled to simply give "trunk" its broadest interpretation. The construction must be reasonable and must be consistent with the specification and how a person of ordinary skill in the art would construe the term. By simply giving "trunk" its broadest interpretation, the Examiner has failed to apply a reasonable standard.

No reasonable construction of "trunk" includes a tube that is merely positioned near the central axis of the tree but provides no support to the tree. Any construction of "trunk" that encompasses Bigman's tube is inconsistent with the plain and ordinary meaning, inconsistent

with the specification, and inconsistent with how a person of ordinary skill in the art would interpret the term.

2. Properly construed “trunk” properly means the primary central support of a tree.

According to MPEP § 2111.01, the words of claims must be given their plain meaning unless inconsistent with the specification. Moreover, claim terms must be consistent with how a person of ordinary skill in the art would interpret the term.

In response to the Non-Final Office Action, Applicant submitted that the term “trunk” means “the main woody axis of the tree.” As understood by one having ordinary skill in the art, the main woody axis refers to the primary central support for the tree. Indeed, a person of ordinary skill in the art construing the term “trunk” in light of the specification would immediately think of the central shaft that provides the primary support for a tree. This construction is supported by the specification. Page 19 of the specification describes a series of branches secured to the trunk. Accordingly, the claimed trunk 212 provides the primary support for the branches. Moreover, Figures 11 and 12 specifically show the trunk 212 disposed in the central axis of the tree. Thus, the specification and figures are consistent with the plain and ordinary meaning of “trunk” as described above. Construing the term “trunk” as the central support system of a tree articulates a broad, yet reasonable construction.

3. The tube in Bigman is not a “trunk.”

The Examiner’s § 103 obviousness rejection is based primarily on Bigman. Bigman discloses a device that dispenses simulated snow pellets onto a tree. See for example, Bigman, Figure 1 and 4. The tree includes a central support 14a that supports a tube 16. A blower drives the pellets through the tube and out an outlet. Thereafter, the pellets are dispensed onto a tree. Properly construed, the term “trunk” does not encompass Bigman’s tube

16. Bigman's tube 16 is not disposed in the main axis of a tree, nor does it provide any support function for the tree. Instead, Bigman's tube 16 is supported by a separate central support 14a. Bigman, col. 2, lines 46-47; see Figure 4. Moreover, Bigman's support 14a provides the primary support system of the tree. Bigman, col. 2, lines 46 and Figure 4. Thus, one of ordinary skill in the art would interpret Bigman's support 14a to be the "trunk" of the tree.

Hence, based on claim construction alone, the rejection of independent claims 1 and 18 is improper because both claims require the air fragrance mixture move at least through a portion of the trunk of a Christmas tree. In Bigman, the pellets of snowflakes or water droplets do not move through the trunk of that tree, but through an adjacent tube.

4. The proffered modification of Bigman destroys the object and purpose of Bigman, and thus the Examiner failed to set forth a prima facie case of obviousness.

If a proposed modification of the prior art destroys the intended function of the prior art, then there is no reason to make the modification and the prima facie case of obviousness fails. See *In re Fitch*, 972 F.2d 1260, 1265 FN. 12, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Here, the Examiner maintains that it would be obvious to substitute the fragrance pellets in Davis et al. for the snowflake or water droplet pellets in Bigman.

Davis discloses heating "scent producing pellets or potpourri" disposed in a fragrance box. Davis, col. 5. lines 24-29, 34. The Examiner's proffered modification of Bigman substitutes the Davis' fragrance pellets for Bigman's snowflake or water droplet pellets. In that case, the modified Bigman reference simply disperses the fragrance pellets.

This modification destroys the object and purpose of the Bigman device. Bigman's tree is designed to dispense out artificial snowflakes or water droplets. If the artificial snowflakes or water droplet pellets are substituted with fragrance pellets, then clearly the Bigman tree will not disperse either snowflake pellets or artificial water droplet pellets. Instead, the modified Bigman reference would disperse the fragrance pellets or scent from the fragrance pellets. This causes

Bigman's tree to be inoperative for its intended purpose, namely, dispensing artificial snowflakes or water droplets. Thus, the obviousness rejection is improper and must be withdrawn.

C. The Proffered Motivation to Combine Claims 5, 6 and 20 is Legally Insufficient and Thus the Claims Are Not Obvious over Bigman in view of Davis et al. and Zins.

Claim 5 is representative and is as follows:

The artificial Christmas tree of claim 1 where at least a portion of the fan is disposed within the trunk of the artificial Christmas tree.

If there is no proper motivation to combine references, then the combination is based on impermissible hindsight and the Examiner has failed to make out a *prima facie* case of obviousness.

The Examiner rejects claims 5, 6, and 20 under § 103 as being obvious over Bigman, in view of Davis et al., in further view of Zins. Claims 5, 6, and 20 each require at least a portion of the fan to be disposed within the trunk or the artificial tree. The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to position the blower/fan in the device taught by Bigman and Davis et al. to place the blower/fan in the trunk to provide the necessary flow of air within the trunk.

Final Office Action, p. 3.

The Examiner's proposed modification is to place a fan in Bigman's tube to provide necessary air flow within the tube 16. This motivation is legally insufficient. The Bigman device already possesses the advantage of having a fan placed in the tube. Specifically, a blower device driven by a motor directs the pellets through an inlet formed in the wall of a venture tube. Bigman, col. 2, lines 28-30. The pellets are driven by the blower through a tube 16 and dispensed at the top end of the tube 16. Bigman, col. 2, lines 44-45. Thus, the results of the proffered motivation are already achieved. In addition, Davis et al. does not suggest providing a

hollow trunk nor does it suggest directing any objects through its trunk. Thus, there would be no reason to supply a fan to provide necessary air flow within the trunk or central support of a tree.

Further, a person of ordinary skill in the art would not be motivated to combine Zins with Davis. Zins teaches a cooling fan in the trunk. Zin's trunk houses lighting elements which generate heat. Zins, col. 2, lines 49-50. The fan cools the interior of the trunk. Zins, col. 4, lines 48-51. Conversely, Davis et al. heats the fragrance pellets so that the pellets will give off a fragrance. Cooling the tree or the trunk through which the air passes would be counterproductive and contrary to the teachings of Davis et al.

D. The Proffered Motivation to Combine Claims 21 and 24 is Legally Insufficient and Thus the Claims Are Not Obvious over Bigman in view of Davis et al. and Hashino.

Claim 21 is representative and is as follows:

The artificial tree of claim 18 wherein the hollow trunk includes a plurality of trunk openings and wherein the air-fragrance mixture moves through at least a portion of the hollow trunk and out the plurality of trunk openings.

The Examiner rejects claims 21 and 24 under § 103 as being obvious over Bigman in view of Davis et al., and in further view of the Japanese patent to Hashino. Claims 21 and 24 each require directing the air-fragrance mixture through at least a portion of the trunk and out the branches of the Christmas tree. The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to pass the air-pellet mixture of Bigman in view Davis et al. through the trunk out the branches.

Final Office Action, p. 4.

A person of ordinary skill in the art would not be motivated to combine Hashino with Bigman and Davis. Hashino teaches a decorative air conditioning device that blows cool air through a tree and out the branches thereof. As with the prior rejection, providing cool air through the tree is counterproductive to producing a fragrance produced by heating pellets. For

example, in Davis et al., electric current heats the fragrance pellets so that the pellets will give off a fragrance. Cooling any portion of the air channels through which the air-fragrance mixture passes will only decrease and inhibit the effectiveness of the device.

Respectfully, the proffered motivation here is conclusionary and not based on any evidence, and as pointed out above, is inconsistent and contrary to the principles involved in generating an air-fragrance mixture from fragrance pellets.

E. CONCLUSION

For the foregoing reasons, the claims as presented are allowable over the prior art made of record, and a notice of allowance is therefore respectfully requested.

(VIII.) CLAIMS APPENDIX

1. An artificial Christmas tree comprising:
 - a. a trunk having an air passageway formed therein;
 - b. a series of Christmas tree branches adapted to extend from the trunk;
 - c. a fragrance source associated with the Christmas tree for emitting a fragrance; and
 - d. a fan to move air across the fragrance source to form an air-fragrance mixture and to move the air-fragrance mixture through at least a portion of the trunk.
5. The artificial Christmas tree of claim 1 where at least a portion of the fan is disposed within the trunk of the artificial Christmas tree.
6. The artificial Christmas tree of claim 5 wherein the fan is disposed within an upper portion of the trunk.
7. The artificial Christmas tree of claim 1 wherein the fragrance source includes a container having a fragrance contained therein.
8. The artificial Christmas tree of claim 7 where the container includes one or more openings and the fragrance comprises a fragrance block.
9. The artificial Christmas tree of claim 1 wherein the fragrance source is disposed within the artificial Christmas tree.
18. An artificial tree comprising:
 - a hollow trunk;
 - a plurality of branches extending from the hollow trunk;
 - an artificial fragrance source associated with the artificial tree, the artificial fragrance source adapted to emit an artificial fragrance; and

a fan configured to direct air past the artificial fragrance source to form an air-fragrance mixture and to move the air-fragrance mixture through at least a portion of the hollow trunk.

19. The artificial tree of claim 18 wherein the fan and the artificial fragrance source are disposed adjacent each other.

20. The artificial tree of claim 18 wherein the fan is disposed within at least a portion of the hollow trunk.

21. The artificial tree of claim 18 wherein the hollow trunk includes a plurality of trunk openings and wherein the air-fragrance mixture moves through at least a portion of the hollow trunk and out the plurality of trunk openings.

22. The artificial tree of claim 18 wherein the fragrance source is adapted to emit a Christmas tree scent.

23. The artificial tree of claim 18 wherein the fragrance source is disposed adjacent the artificial tree.

24. The artificial tree of claim 18 wherein the fan directs the air-fragrance mixture through at least a portion of the trunk and out the branches.

25. The artificial tree of claim 18 wherein the fan and the fragrance source are contained in a housing or container.

26. The artificial tree of claim 18 wherein the tree is at least partially supported by a container, and wherein the fan and the fragrance source are contained within the container.

(IX.) EVIDENCE APPENDIX

None.

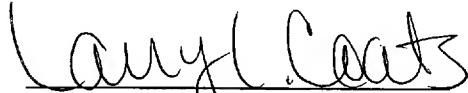
(X.) RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

Appeal Brief for Application Ser. No. 10/797,490
Attorney Docket No. 4486-096

Respectfully submitted,

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